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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 54084-62559	
I hereby certify that this correspondence has been electronically filed with the U.S. Patent and Trademark Office via the EFS Web on <u>November 9, 2009</u>		Application Number 10/586,018	Filed 11/15/2004
Signature <u>Joseph M. Rolnicki</u>		First Named Inventor Scheller et al.	
Typed or printed name <u>Joseph M. Rolnicki</u>		Art Unit 3739	Examiner Chen, Victoria W.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 32653
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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November 9 2009
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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Joseph M. Rolnicki
Joseph M. Rolnicki
Reg. No. 32,653

In re Application of: Scheller et al.	:	
	:	Examiner: Chen, Victoria W.
Serial No. 10/586,018	:	
	:	Group Art Unit: 3739
Filed: November 15, 2004	:	
	:	
For: SURGICAL INSTRUMENT	:	
HANDLE WITH ADJUSTABLE	:	
ACTUATOR POSITION	:	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

It is respectfully requested that the Final Rejection of claims 1, 3-10, 12 and 13 of the above-referenced patent application made in the Office Action having a notification date of August 14, 2009, be reviewed. The rejection of the claims is based on clear errors in the interpretation of the disclosures of the prior art references relied on in the rejections of the claims, on errors made in interpreting the language of the claims, and on errors in the requirements for anticipation rejections under the patent law.

Claims 1, 3-10, 12 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of the U.S. Patent of Richards No. 5,634,918. Of these rejected claims, claims 1, 3 and 8 are independent claims. Claims 4-7, 12 and 13 depend from claim 3, and claim 9 and 10 depend from claim 8. It is respectfully submitted that the independent claims 1, 3 and 8 recite elements of the invention that are not identically shown by the Richards reference. The rejection is based on factual errors made in what the Richards reference actually discloses, and on legal errors in appropriately constructing the claim language. Therefore, the Richards reference does not anticipate the subject matter of these claims under the patent law.

For a prior-art reference to anticipate, every element of the claimed invention must be identically shown in a single reference.

In Re Bond, 910 F.2d 831, 15 USPQ 2d 1566, 1567 (Fed. Cir. 1990).

[A]ny degree of physical difference, however slight, invalidates claims of anticipation.

Ultradent Products, Inc. v. Life-Like Cosmetics, Inc., 924 F. Supp. 1101, 39 USPQ 2d 1969, 1980 (D. Utah 1996), *aff'd in part, rev'd in part on other grounds*, 127 F.3d 1065, 44 USPQ 2d 1336 (Fed. Cir. 1997).

Anticipation requires identity of invention. The claimed invention, as described in appropriately construed claims, must be the same as that of the reference in order to anticipate.

Glaverbel Societe Anonyme v. Northlake Marketing & Supply, Inc., 45 F.3d 1550, 33 USPQ 2d 1496, 1498, 1995-1 Trade Cas. (CCH) P 70891 (Fed. Cir. 1995).

Claim 1 recites a surgical instrument having an elongate rod 14 and a forward grip member 82 mounted on the rod. The claim further recites "the forward grip member having a plurality of resilient arms that extend along the rod." Claim 3 recites a surgical instrument having an elongate rod 14 and a forward grip member 82 operatively connected with the rod. Claim 3 further recites "a plurality of resilient arms integrally connected with the forward grip member." Claim 8 also recites a surgical instrument having an elongate rod 14 and a forward grip member 82 operatively connected with the rod." The claim further recites "a plurality of resilient arms operatively connected with the forward grip member."

Each of the independent claims discussed above recites a forward grip member 82 having a plurality of resilient arms 102.

In the latest anticipation rejection of the independent claims 1, 3, and 8, the rejection refers to Figure 4 of the Richards reference and interprets the rod 14 of Figure 4 as the rod recited in claims 1, 3, and 8. The rejection further interprets the six triggers 20 shown in Figure

4 as “a forward grip member” 82 as recited in claims 1, 3, and 8. The “Response to Arguments” explains that the examiner is interpreting the six separate triggers 20 of Richards as “a forward grip member.” It is respectfully submitted that interpreting six separate members as a member, which is the same as interpreting the six triggers of Richards as the claimed “a forward member” is not appropriately construing the language of claims 1, 3 and 8. Therefore, the Richards reference does not anticipate claims 1, 3 and 8 under the earlier-cited case law.

Independent claims 1, 3 and 8 also recite a forward grip member having a plurality of resilient arms. In viewing Figures 3 and 3A of the Richards reference, it can be seen that each trigger 20 has only one tie arm 20T and only one hook 20H at the distal end of the tie arm (see column 3, lines 25-31 of the Richards reference). What the Richards reference actually does disclose is a plurality of triggers 20, with each trigger having only one tie arm 20T and only one hook 20H at the distal end of the tie arm.

Appropriately construing the language of the independent claims 1, 3, and 8, as is required by the above-cited case law, the Richards reference does not identically show a forward grip member having a plurality of resilient arms, and therefore does not identically show every element of the claimed invention recited in the independent claims 1, 3, and 8, as required for a proper anticipation rejection under the above-cited case law. The Richards reference therefore does not anticipate claims 1, 3-10, 12, and 13 as contended in the rejection of claims 1, 3-10, 12, and 13.

Furthermore, independent claim 1 recites the elongate rod 14 having a distal end 42 that is adapted to be attached to a surgical instrument head, the piston 16 being mounted on the rod adjacent the rod distal end 42, and the plurality of arms having distal ends 92 that operatively engage with the piston 16 whereby manual movement of the arm distal ends 92 radially inwardly moves the piston 16 axially toward the rod distal end 42 and movement of the piston 16 axially away from the rod distal end 42 moves the arm distal ends 92 radially outwardly.

Independent claim 3 also recites the elongate rod 14 having a distal end 42 adapted to be attached to a surgical instrument head, a piston 16 mounted on the rod 14 adjacent the rod distal end 42, and a plurality of resilient arms 102 operatively connected with the piston 16 whereby manual movement of the arms 102 radially inwardly moves the piston 16 axially toward the rod distal end 42, and movement of the piston 16 axially away from the rod distal end 42 moves the arms 102 radially outwardly.

Independent claim 8 also recites an elongate rod 14 having a distal end 42 adapted to be attached to a surgical instrument head, a piston 16 mounted on the rod 14 adjacent the rod

distal end 42, and a plurality of resilient arms 102 operatively connected with the piston 16 whereby manual movement of the arms 102 radially inwardly moves the piston 16 axially toward the rod distal end 42, and movement of the piston 16 axially away from the rod distal end 42 moves the arms radially outwardly.

In the latest anticipation rejection of claims 1, 3, and 8, the rejection refers to Figure 4 of the Richards reference and interprets the rod 14 as the rod of claim 1. It therefore appears that the forward end 18 of the rod 14 in the Richards reference is interpreted as the claimed rod distal end 42 because the forward end 18 is the end that is adapted for attachment to a surgical instrument head as recited in the rejected claims. The rejection of claims 1, 3, and 8 also interprets the tie arms 20T as the claimed plurality of resilient arms and contends that the plurality of resilient arms 20T, 20H “operatively engage the piston [via elements 22 and 32], whereby manual movement of the arm distal ends radially inwardly [Fig. 4], moves the piston axially toward the rod distal end [Fig. 4], and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly [Fig. 3],” (quoting from the rejection of independent claim 3). However, this interpretation of what is shown in Fig. 3 and Fig. 4 of the Richards reference is incorrect

The interpretation relies on the entirety of both the length of the trigger tie arm 20T and the tie arm hook 20H as the claimed “arms having distal ends that operatively engage with the piston,” and the plurality of arms “operatively connected with the piston.” However, only the tie arm hooks 20H are described by Richards as being at the tie arm distal end (column 3, lines 28-30) and only the tie arm hooks 20H engage in the grooved region 24 of the trigger retainer 22. The tie arm 20T is described as being curved to circulate around the rod (column 3, lines 28-30) and is not described as engaging with anything. Only the tie arm hooks 20H operatively engage the piston and the interpretation that the tie arms 20T also operatively engage the piston is based on an incorrect interpretation of the Richards reference.

Referring to Figures 3 and 4 of the Richards reference, Figure 3 shows the piston 34 moved away from the rod distal end 18, and Figure 4 shows the piston 34 moved toward the rod distal end 18. In Figure 3, the tie arm hooks 20H are radially closer to the center axis 26 of the rod than are the tie arm hooks 20H shown in Figure 4. Thus, when the tie arm hooks 20H of the Richards reference are moved toward the center axis 26 of the rod or radially inwardly, the piston 34 is moved away from the rod distal end as shown in Figure 3, and not toward the rod distal end as claimed. In addition, when the tie arm hooks 20H in the Richards reference are

moved away from the rod center axis 26 or radially outwardly as shown in Figure 4, the piston 34 is moved toward the rod distal end 18, and not away from the rod distal end as claimed.

The Richards reference therefore does not identically show every element of the invention recited in independent claims 1, 3, and 8 as is required for a proper anticipation rejection under the above-cited case law. Interpreting the language of the independent claims 1, 3, and 8 reasonably, the Richards reference does not identically show every element of the claimed invention. The Richards reference therefore does not anticipate claims 1, 3, and 8, and claims 1-14 currently pending in the application are allowable over the prior art.

Respectfully submitted,

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